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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/559,881   | 04/26/2000  | Michael R. Schrimpf  | 6494.US.O2          | 1781             |
| 23492  | 7590        | 03/18/2004           |                     |                  |
| STEVEN F. WEINSTOCK<br>ABBOTT LABORATORIES<br>100 ABBOTT PARK ROAD<br>DEPT. 377/AP6A<br>ABBOTT PARK, IL 60064-6008 |             |                      |                     |                  |
| EXAMINER<br>COLEMAN, BRENDA LIBBY  |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1624   |             |                      |                     |                  |

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                   |                 |  |
|------------------------------|-------------------|-----------------|--|
| <b>Office Action Summary</b> | Application No.   | Applicant(s)    |  |
|                              | 09/559,881        | SCHRIMPF ET AL. |  |
|                              | Examiner          | Art Unit        |  |
|                              | Brenda L. Coleman | 1624            |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,7,8,19,20,22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,20 and 22 is/are allowed.
- 6) ☒ Claim(s) 7,19 and 24 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date: _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____  | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Claims 1, 2, 7, 8, 19, 20, 22 and 24 are pending in the application.

This action is in response to applicant's amendment filed November 20, 2003.

Claims 3-6, 9-18, 21, 23 and 25-38 have been canceled and claims 1, 7, 20 and 22 have been amended.

### Response to Amendment

Applicant's amendments filed November 20, 2003 have been fully considered with the following effect:

1. With regards to the rejection of Claims 1, 2 and 19-28 as being drawn to an improper Markush group in the last office action, the applicant's amendments and arguments have been fully considered but are not found persuasive with respect to claim 19. The applicant's stated that Claim 1, and dependent claims 2, 7-8 and 19 have been amended to relate to subject matter within the scope of Claim 1 wherein Z is pyrrolidinyl moiety and is directed to the elected subject matter in the present application. However, claim 19 has not been amended to remove the species, which are directed to non-elected subject matter, i.e. about the middle of page 6 onward.

Claim 19 is rejected as being drawn to an improper Markush grouping. For reasons of record and stated above.

2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejections of claims 25-28 of the last office action, which is hereby **withdrawn**.

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3. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 21, 22 and 25-28 of the last office action, which are hereby **withdrawn**.

In view of the amendment dated November 20, 2003, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

4. Claims 7, 19 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reason(s) apply:

- a) Claim 7 is vague and indefinite in that it is not further limiting.
- b) Claim 19 recites the limitation "piperidinyl, azepnayl, etc." in the species spanning the middle of page 6 to page 10. There is insufficient antecedent basis for this limitation in the claim.
- c) Claim 24 recites the limitation "pain" in the method of use of the compounds. There is insufficient antecedent basis for this limitation in the claim.

***Claim Objections***

5. Claim 8 is are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


***Allowable Subject Matter***

6. Claims 1, 2, 20 and 22 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00 Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 571-272-0674. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Brenda Coleman  
Primary Examiner Art Unit 1624  
March 12, 2004